

Application Serial No. 10/576,337
Attorney Docket No. S1011/20247
Amendment Dated October 6, 2009

REMARKS/ARGUMENTS

By this Amendment, Claims 1 and 33 have been cancelled, Claims 26, 28-29, 31 and 34-36 have been amended and new Claim 38 added has been cancelled. Thus, Claims 26, 28-31 and 34-38 are pending.

The Examiner has rejected Claims 1, 26-31 and 33-37 under 35 U.S.C. §112, second paragraph as being indefinite and in particular identifies the phrase “zip arrangement that provides both an opening closing facility and additional selective expansion” as being inconsistent. To that end, Applicant has included new Claim 38 to more clearly specify the zipper configuration of the present invention.

The Examiner has rejected Claims 1, 26, 34 and 35 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,390,259 (Lu, hereinafter “Lu”) in view of U.S. Patent Publication No. 2004/0101669 (Chang, hereinafter “Chang”) and U.S. Patent No. 5,004,091 (Natho, et al., hereinafter “Natho”). In particular, the Examiner asserts that:

...Lu teaches a wheeled luggage with a lid and a base with expandable body. Lu does not teach the body and lid made from EVA. Chang teaches that it is known in the art to provide a luggage body that is made from EVA without any peripheral support. It would have been obvious to one of ordinary skill in the art to make the body and the lid from EVA to provide the desired material for the luggage. With respect to the lid and base forming sections are molded as one-piece tray, Natho teaches that it is known in the art to provide both the body and lid can be made from molded as one-piece tray EVA. Thus, to make the two sections of Chang from moulded EVA without any peripheral support would have been obvious to provide the desired material for the luggage. (Final Rejection dated July 7, 2009, p. 2).

To that end, Applicant has cancelled Claim 1 and replaced it with Claim 38. In particular, Claim 38 specifies that, among other things, the present invention has no “internal or external perimeter framing around an entire periphery of the lid or base sections.” In contrast,

the suitcase of Lu uses a main *frame* 23¹. In addition, Claim 38 specifies that the lid and base are hinged together. In contrast, Lu requires an auxiliary body 15 to which the cover 12 is hinged and that that entire assembly sandwiches a flexible section 13 between itself and the main frame 23²; moreover, the assembly and the main frame 23 are coupled via a support mechanism 30 that is not a hinge but rather a ratchet mechanism³. Furthermore, Lu fails to teach or suggest a two zip fastener mechanism as specified in Claim 38. Thus, not only does Lu fail to teach or suggest a body made from EVA, Lu also fails to teach or suggest these other specified features of Claim 38 just discussed.

To make up for the deficiency of Lu which omits the use of EVA, the Examiner cites Chang. The invention of Chang is directed to multi-layered board devices which can be used in file holding devices, notebooks and luggage members. The multi-layered board device comprises a laminate of five layers⁴ of which three layers (viz., layers 2 and 3) may comprise EVA⁵; the composition of the intermediate layers 4 is not taught or suggested by Chang as comprising EVA. Chang also teaches the use of this laminate for “forming the outer cover or the outer peripheral wall members of the file holding devices, the suitcases, or the luggage members, etc.”⁶ There is no teaching or suggestion in Chang for creating an overall shell or tray of the luggage member using EVA. Thus, even if one skilled in the art were to combine Lu and Chang, the resulting combination would still not teach or suggest the invention of the present application.

¹ Lu, col. 2, lines 55-64.

² Lu, col. 2, lines 55-64; Fig. 3;

³ Lu, col. 2, line 65-col. 3, line 51;

⁴ Chang, Fig. 3;

⁵ Chang, paragraphs 0020-0022;

To make up for the deficiency in Lu and Chang providing both a body and lid made from molded one-piece EVA trays without any peripheral support, the Examiner cites Natho. However, in asserting that it would have been obvious to one skilled in the art combine Lu/Chang with Natho, the Examiner failed to address how the support mechanism 30 of Lu would be secured to the proposed one-piece EVA trays *without any peripheral support* of Natho. Natho nor Chang teach or suggest the use of an expanding volume. Therefore, the devices of Natho and Chang do not have to account for the loading that is created by the support mechanism 30 of Lu and, most likely, the one piece EVA tray would fail due to the stress. Thus, Applicants submit that it would not have been obvious to one skilled in the art to combine Lu, Chang and Natho and that even if one skilled in the art did combine them, the result would still not be the invention of the present application.

Thus, for all of these reasons, Applicant respectfully submits that new Claim 38, as well as Claims 26 and 34-35 are patentable over the cited art.

The Examiner has rejected Claim 26 based on Lu, asserting that Lu teaches the selective expansion of the storage volume of the suitcase via a zipper as claimed. Applicant respectfully disagrees for the following reasons. Claim 26 is now dependent upon Claim 38 and is patentable for the same reasons. The activation of the zipper 221 (Fig. 6 of Lu) does not cause the expansion or contraction of the storage volume; rather, it is the support mechanism 30 that causes the expansion or contraction of the storage volume⁶. In particular, opening or closing the zipper 221 does not permit the suitcase of Lu to expand or contract its storage volume; rather, displacement of the sliding board 40 does. Thus, for all of these reasons, Applicant respectfully

⁶ Chang, paragraph 0008;

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submits that Claim 26 is patentable over the cited art.

The Examiner has rejected Claim 28 as being unpatentable under 35 U.S.C. §103(a) over Lu in view of U.S. Patent no. 2,912,080 (Ikelheimer, hereinafter “Ikelheimer”). However, Applicant respectfully disagrees for the following reasons. The corrugations 23 created in Ikelheimer are not visible at the corners of the lid and of the base. In particular, as shown most clearly in Ikelheimer, the corrugations 23:

...are concealed by the band 25 and where they taper off into nothing, they are concealed by the rib or bead which is exposed and forms the outer edge of the welt 29. (emphasis added, Ikelheimer, col. 2, lines53-56).

In fact, the corners of the case 10 are shown as smooth rounded corners with no corrugations. The corrugations 23 of Ikelheimer do not teach or suggest the elimination or reduction of wrinkles during the application of material around the molded portion. If this were the case, any material applied to the molded portion would be clearly visible at the corners. Thus, for all of these reasons, Applicant respectfully submits that Claim 28 is patentable over the cited art.

The Examiner has rejected Claims 29-30 as being unpatentable under 35 U.S.C. §103(a) over Lu in view of U.S. Patent No. D492,110 (Van Himbeeck). However, since Claims 29-30 ultimately depend from new Claim 38, they are patentable for the same reasons.

The Examiner has rejected Claim 31 as being unpatentable under 35 U.S.C. §103(a) over Lu in view of U.S. Patent No. U.S. Patent No. 6,062,356 (Nykoluk) and over Lu in view of U.S. Patent No. 4,773,515 (Kotskin). However, since Claim 31 depends from new Claim 38, it is patentable for the same reasons.

⁷ Lu, col. 3, lines 52-col. 4, line 19;
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The Examiner has rejected Claims 36-37 as being unpatentable under 35 U.S.C. §103(a) over Lu in view of U.S. Patent No. 6,629,588 (Nykoluk, et al.) or in view of U.S Patent No. 5,447,261 (Mitomi, et al.). However, since Claims 36-37 now ultimately depend from new Claim 38, they are patentable for the same reasons.

The Examiner has also rejected Claims 26, 29, 30-32, 34 and 35 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent Publication No. 2005/0056511 (Hsieh, hereinafter “Hsieh”) in view of Nykoluk ‘356 and further in view of Chang or Natho. In particular, the Examiner asserts that Hsieh discloses all of the claimed limitations except for the material being foamed plastics EVA. To make up for that deficiency, the Examiner cites Chang or Natho as teaching the use of foamed plastic EVA for use in producing luggage. The Examiner then asserts that it would have been obvious to one of ordinary skill in the art

...to provide foamed plastic Lee [U.S. Patent No. 5,284,542] to provide the desired material for the luggage. With respect to the zipper arrangement that provide the expansion, Nykoluk teaches that it is known in the art to provide a zipper arrangement having additional expansion along with the piping support. It would have been obvious to one of ordinary skill in the art to provide the zipper arrangement having additional expansion as taught by Nykoluk to enable one to store additional material. (Final Rejection, p. 4).

Applicant respectfully disagrees for the following reasons.

As specified in new Claim 38, the lid section and the base section are “moulded as one-piece tray-like forms”. In contrast, Hsieh teaches the use of several portions to form each of the two shell members 2, namely, side shell part 21, top shell part 22 and bottom shell part 23. Thus, Hsieh teaches away from the invention of the present application and thus fails to teach this unitary feature of the lid and base sections, as well as the expansion/contraction feature of the present invention. As to the feature of Chang teaching the use of EVA in luggage, this has

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been previously discussed and the same arguments apply here. Furthermore, although Natho teaches the use of EVA, it also directed to carrying cases for an article as a television camera, the article requiring protection against impact as it is being carried from place to place⁸; thus, one skilled in the art would not combine Natho with Hsieh since the luggage of Natho is counterintuitive to expansive volume; rather, the thrust of Natho is to provide constricted volume to provide maximum protection to its contents.

As to the Examiner's reference to U.S. Patent No. 5,284,542 (Lee, hereinafter "Lee"), there is no teaching or suggestion of forming a luggage unit as specified in Claim 38 and is simply directed to forming a covered EVA panel that can be used with a luggage unit.

With regard to Nykoluk '356, although that reference discloses the use of dual zipper fasteners (along with piping support) for additional expansion volume, there is teaching or suggestion for combining Hsieh with Nykoluk '356. In fact, with the multi-component design of Hsieh, it is unclear how those components could be combined with the dual zipper arrangement of Nykoluk '356 while maintaining structural integrity of the overall Hsieh/Nykoluk combination⁹.

It appears that the Examiner is using the present invention as a template to "build the invention" from the references which is not permitted¹⁰.

⁸ Natho, col. 1, lines 5-8;

⁹ Nykoluk '356 requires the use of an internal frame member or frame 33 comprising a substantially *rigid* material (Nykoluk '356, col. 2, lines 30-32) which supports the notion that one skilled in the art would not combine Hsieh with Nykoluk '356.

¹⁰ Moreover, the PTO may not "use the claimed invention as an instruction manual or 'template' to piece together the teachings of the prior art so that the claimed invention is rendered obvious." *In re Fritch*, 23 U.S.P.Q.2d780 (Fed. Cir. 1992).

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Thus, for all of these reasons, Applicant respectfully submits that Claims 26, is patentable over the art of record and respectfully requests that this §103(a) rejection be withdrawn.

The Examiner has rejected Claim 28 under 35 U.S.C. §103(a) as being unpatentable over Hsieh in view of Ikelheimer. However, Claim 28 depends from Claim 38 and is patentable for the same reasons. Furthermore, for the reasons discussed previously with regard to the combination of Lu and Ikelheimer, Applicants assert that the combination of Hsieh/ Ikelheimer also do not teach or suggest the invention of Claim 28; thus, Applicants respectfully submit that Claim 28 is patentable over the art of record.

The Examiner has rejected Claims 36-37 under 35 U.S.C. §103(a) as being unpatentable over Hsieh in view of Nykoluk '588 or Mitomi. However, Claims 36-37 ultimately depend from Claim 38 and are patentable for the same reason; thus, Applicants respectfully submit that Claim 28 is patentable over the art of record.

Furthermore, Applicant wishes to make of record several references that recently came to Applicant's attention in a corresponding Chinese application (viz., Chinese Patent No. ZL 200410088241.2) that has been allowed over these references. To that end, Applicant encloses herewith a supplementary information disclosure statement listing those references.

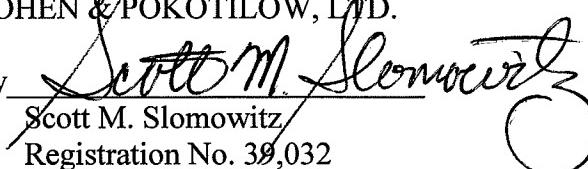
In view of the foregoing, Applicant respectfully submits that Claims 26, 28-31 and 34-38 are patentable over the art of record and respectfully request that the §103(a) rejection be withdrawn. Thus, Applicant respectfully submits that Claims 26, 28-31and 34-38 are now in condition for allowance.

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Should the Examiner believe that anything further is desirable in order to place the application in even better condition for allowance, the Examiner is invited to contact Applicant's undersigned attorney at the telephone number listed below.

Respectfully submitted,

CAESAR, RIVISE, BERNSTEIN,
COHEN & POKOTILOW, LTD.

By 
Scott M. Slomowitz
Registration No. 39,032
Customer No. 03000
(215) 567-2010
Attorneys for Applicant

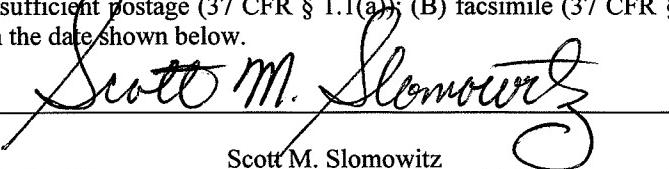
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Date: October 6, 2009

Signature: 

Name: Scott M. Slomowitz